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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,522	08/29/2001	Wolf-Dietrich Bebenroth	GK-EIS-1044 / 500593.2003	9625
26418	7590	03/25/2005	EXAMINER	
REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650			FAULK, DEVONA E	
			ART UNIT	PAPER NUMBER
			2644	

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/942,522

**Applicant(s)**

BEBENROTH, WOLF-DIETRICH

**Examiner**

Devona E. Faulk

**Art Unit**

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/18/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5 and 8-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 2644

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments, filed 3/18/2005, with respect to the rejection(s) of claim(s) 1, 3-6, and 8-10 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Wilton.
2. Claims 2, 4, 6, 7 are cancelled.

***Claim Rejections - 35 USC § 112***

3. Regarding claims 1, 14, and 15 the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
4. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 15 recites "a slipping clutch". Although the applicant does mention a slipping clutch, it is not clear as to what it means. A clutch is defined as something that grasps, something that connects or disconnects. The applicant has interpreted the slipping clutch as a clutch that can easily lose its grip or easily disconnected.


Art Unit: 2644

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1,5,8,9,10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuman et al. (U.S. Patent 5,642,426) in view of Barwig et al. (U.S. Patent 5,001,762) in further view of Wilton et al. (U.S. Patent 6,130,953).

Regarding claims 1 and 14, Neuman discloses a circuit housing having an electrical circuit for a headset, such as for a chin loop headset (integral radio and infrared assistive listening device; Figure 1; column 3, lines 42-46). He further teaches that the ~~a~~  portion of the cover is transmissive for infrared rays (column 3, lines 51-55). Although he teaches also on a volume control, he fails to disclose wherein rotating said cover actuates said electrical circuit for controlling volume. However the concept of rotating a cover to actuate a circuit and control volume was well known in the art at the time of filing as taught by Barwig. Barwig discloses a volume control and integrated assembly (10) where the volume control is a rotatable circular cap (column 2, lines 53-57) (reads on circular cover of claim 14). It would be obvious to use Barwig's concept of a

Art Unit: 2644

rotating cover to actuate a circuit to control volume in order to be able to adjust power and volume. Neuman as modified by Barwig fails to disclose that the entire cover (and entire circular cover) is transmissive for infrared rays. However, this concept was well known in the art at the time of filing as taught by Wilton. Wilton discloses a headset with an earphone having a infrared transmissive circular cover (42, Figure 3; column 5, lines 23-26 and lines 36-40). Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Neuman as modified by Barwig by having an entire cover transmissive for infrared rays in order to allow transmission of infrared light.

Claim 5 claims the circuit housing of claim 1 wherein said housing is circular-cylindrical. Neuman as modified by Barwig and Wilton meets all elements of claim 1. Therefore, the combination meets all elements of claim 5 with the exception of the housing having a circular-cylindrical shape. The shape of Neuman's housing is showed in Figure 5. Myers discloses a circular shaped housing. All elements of claim 5 are comprehended by claim 1. Claim 5 is rejected for reasons given above apropos of claim 1.

Claim 8 claims the circuit housing of claim 1, wherein provided on the outside of the housing is at least one further actuating element of the circuit. Neuman as modified by Barwig and Wilton meets all elements of claim 1. Therefore, the combination meets all elements of claim 8 with the exception of at least one further actuating element of the circuit provided on the outside of the housing. Neuman

Art Unit: 2644

further teaches of a selector switch (10, Figure 5) and an on/off switch (20, Figure 5), and of an IR receiver (8, Figure 5), which obviously would be disposed on the outside of the housing. All elements of claim 8 are comprehended by claim 1. Claim 2 is rejected for reasons given above apropos of claim 1.

Claim 9 claims the circuit housing of claim 8, wherein said further actuating element is a button. Neuman as modified by Barwig and Wilton meets all elements of claim 1. Therefore, the combination meets all elements of claim 9 with the exception of the actuating element being a button. Neuman's Figure 5 indicates that both the selector switch (10) and the on/off switch (20) are buttons. All elements of claim 9 are comprehended by claim 8. Claim 9 is rejected for reasons given above apropos of claim 8.

Claim 10 claims the circuit housing of claim 8 wherein said actuating element is arranged in a recess at the outside of the housing. Neuman as modified by Barwig and Wilton meets all elements of claim 1. Therefore, the combination meets all elements of claim 10 with the exception that the actuating element is arranged in a recess at the outside of the housing. Neuman's Figure 5 indicates that both the selector switch (10) and the on/off switch (20) are buttons and it is obvious from the figure that they are arranged in a recess at the outside of the housing. All elements of claim 10 are comprehended by claim 8. Claim 10 is rejected for reasons given above apropos of claim 8.

Art Unit: 2644

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neuman et al. (U.S. Patent 5,642,426) in view of Barwig et al. (U.S. Patent 5,001,762) in further view of Wilton et al. (U.S. Patent 6,130,953) in further view of Myers et al. (U.S. Patent 5,751,825) .

Claim 3 claims the circuit housing of claim 1 wherein said cover has a scale, which cooperates with a marking on the housing. Neuman as modified by Barwig and Wilton meets all elements of claim 3. Therefore, the combination meets s all elements of claim 3 with the exception of the cover having a scale, which cooperates with a marking on the housing. Myers discloses the claimed matter (Figure 1; column 3, lines 44-58). Thus, it would have been obvious to one of ordinary skill in the art to have a scale on the cover as taught by Myers in order to read the tempo.

8. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuman et al. (U.S. Patent 5,642,426) in view of Barwig et al. (U.S. Patent 5,001,762) in further view of Wilton et al. (U.S. Patent 6,130,953) in further view of Such (U.S. Patent 5,457,751) .

Claim 11 claims the circuit housing of claim 8 wherein said further actuating element is arranged at the rear side of the housing, which is in opposite relationship to the cover. Neuman as modified by Barwig and Wilton meets all elements of claim 8. Therefore, the combination meets all elements of claim 11 with the exception of the further actuating element being arranged at the rear side of the housing which is in opposite relationship to the cover. Such

Art Unit: 2644

discloses an actuating element on the side (52, Figure 5). It is therefore obvious that an actuating element can be placed in the rear if desired. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to place at least one other actuating element on the rear side of the housing for the benefit of having distinct location of controls.

Claim 12 claims the circuit housing of claim 11, wherein said rear side further comprises a recess accommodating said further actuating element. Neuman as modified by Barwig and Wilton meets all elements of claim 11. Therefore, the combination meets all elements of claim 12 with the exception of the claimed matter. Neuman's Figure 5 indicates that both the selector switch (10) and the on/off switch (20) are buttons and it is obvious from the figure that they are arranged in a recess at the outside of the housing. All elements of claim 12 are comprehended by claim 11. Claim 11 is rejected for reasons given above apropos of claim 12.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neuman et al. (U.S. Patent 5,642,426) in view of Barwig et al. (U.S. Patent 5,001,762) in further view of Wilton et al. (U.S. Patent 6,130,953) in further view of Dascal et al. (U.S. Patent 3,902,120).

Claim 13 claims the circuit housing of claim 1 further comprising a socket for accepting a stereo jack plug. Neuman as modified by Barwig and Wilton meets all elements of claim 1. Therefore, the combination meets all elements of claim 13 with the exception of the claimed matter. Dascal discloses a circuit housing (32) with a stereo



Art Unit: 2644

jack or socket (42, Figures 3, 4). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to use Dascal's concept of a circuit housing having a stereo socket in order to provide an external stereo signal.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neuman et al. (U.S. Patent 5,642,426) in view of Barwig et al. (U.S. Patent 5,001,762) in view of Myers et al. (U.S. Patent 5,751,825) in further view of Wilton et al. (U.S. Patent 6,130,953) in further view of Blaser et al. (U.S. Patent 5,148,715).

Regarding claim 15, Neuman discloses a circuit housing having an electrical circuit for a headset, such as for a chin loop headset (integral radio and infrared assistive listening device; Figure 1; column 3, lines 42-46). He further teaches that a portion of the cover is transmissive for infrared rays (column 3, lines 51-55). Although he teaches also on a volume control, he fails to disclose wherein rotating said cover actuates said electrical circuit for controlling volume. Although he teaches also on a volume control, he fails to disclose wherein rotating said cover actuates said electrical circuit for controlling volume. However the concept of rotating a cover to actuate a circuit and control volume was well known in the art at the time of filing as taught by Barwig. Barwig discloses a volume control and integrated assembly (10) where the volume control is a rotatable cap (column 2, lines 53-57). It would be obvious to use Barwig's concept of a rotating cover to actuate a circuit to control volume in order to be able to adjust power and volume.

Art Unit: 2644

Neuman as modified by Barwig fails to disclose a potentiometer as claimed. Myers discloses a potentiometer (52, Figure 2B) connected to a cover of a housing for a headset. Neuman as modified by Barwig and Myers fails to disclose that the entire cover (and entire circular cover) is transmissive for infrared rays. However, this concept was well known in the art at the time of filing as taught by Wilton. Wilton discloses a headset with an earphone having an infrared transmissive circular cover (42, Figure 3; column 5, lines 23-26 and lines 36-40). Neuman as modified by Barwig and Myer and Wilton fails to disclose that the cover is connected to a potentiometer of the circuit by a slipping clutch. However, this concept was well known in the art at the time of filing as taught by Blaser. Blaser discloses the concept of a potentiometer (22, Figure 2) connected to a slipping clutch (6; Figure 2) (column 1, lines 28-32; Figure 2). Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Neuman as modified by Barwig and Myers and Wilton by having an the potentiometer connected to the cover by a slipping clutch in order to facilitate adjusting between the cover and the housing.

#### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devona E. Faulk whose telephone number is 703-305-4359. The examiner can normally be reached on 8 am - 5 pm.

Art Unit: 2644

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 703-305-4040. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**SINH TRAN**  
**SUPERVISORY PATENT EXAMINER**

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